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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/736,631 | 12/14/2000 | Charles M. Link II | BELL-0023/99213 | 8042 |
| 23377 | 7590 | 02/23/2005 | EXAMINER | |
| WOODCOCK WASHBURN LLP ONE LIBERTY PLACE, 46TH FLOOR 1650 MARKET STREET PHILADELPHIA, PA 19103 | | | WOO, STELLA L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2643 | |

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/736,631

Applicant(s)

LINK ET AL.

Examiner

Stella L. Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 18, 20-30, 32 and 34-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 18, 20-30, 32 and 34-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 18 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 16 and 30 recites signaling "according to a two-way on-hook signaling protocol." However, claims 18 and 32, which depend from claims 16 and 30 respectively, recite signaling "according to a Bell 202 modem signaling protocol" which Applicant describes as a one-way signaling protocol (see applicant's Specification, page 13, lines 7-9). Therefore, it is unclear as to whether a one-way or two-way signaling protocol is being claimed.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 16, 18, 20, 22-30, 32, 34, 36-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bossemeyer, Jr. et al. (US 6,490,444, hereinafter "Bossemeyer") in view of Vonder Haar et al (US 6,137,878, hereinafter "Vonder Haar").

Regarding claims 16, 18, 20, 22-30, 32, 34, 36-47, Bossemeyer discloses a system for notifying a computing device (subscriber terminal 60 can be a personal computer; col. 5, line 66 - col. 6, line 4) of an incoming message (data message), the system comprising:

a message server (data message platform 40 coupled to a data network 200; Fig. 2; Fig. 3, step 100) for receiving the incoming message (data message is received at the data message platform; Fig. 6, step 100);

a public communications system (telecommunications network 60 coupled to data message platform 40), the message server for securely communicating to the communications system that the incoming message awaits retrieval by the computing device (message waiting signal is transmitted to the telecommunications network; Fig. 6, step 104); and

a communications line (telephone line connecting telecommunications network node 250 with subscriber terminal 80), the communications system for signaling the computing device over the communications line that the incoming message awaits retrieval by such computing device (message waiting indication is transmitted to the subscriber terminal; Fig. 6, step 108),

wherein the incoming message includes a destination address (subscriber's email address; col. 3, lines 60-61), and wherein the communications line is identified by an identifier (telephone number of the subscriber; col. 3, lines 59-60), the system further comprising a database (subscriber database 230 is indexed by message address so that the subscriber's telephone number is retrieved so that a message waiting indication can be transmitted to the subscriber via the telephone line; col. 4, lines 17-46).

Bossemeyer differs from claims 16, 18, 20, 22-30, 32, 34, 36-47 in that it does not specify signaling according to a two-way on-hook signaling protocol. However, Vonder Haar

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teaches the well known use of a two-way on-hook signaling protocol for transmitting data to a telephony apparatus (bi-directional ADSI protocol; col. 6, line 48 – col. 7, line 2) such that it would have been obvious to an artisan of ordinary skill to incorporate such a well known on-hook data signaling protocol, as taught by Vonder Haar, within the system of Bossemeyer for communication email notification messages.

Regarding claims 18 and 32, Vonder Haar teaches that ADSI is a bi-directional protocol based on DTMF and Bell 202 modem signaling (col. 6, lines 55-58).

Regarding claims 20, 23, 25, 26, 27, 34, 37, 39, 40, 41, in Bossemeyer, the communication system involves a telecommunications network 60 with a telephone line to subscriber terminal 80 (see Figure 2), the line identifier is a telephone number associated with the email address (see Fig. 6, step 140) and a message is transmitted to the telephone line indicating that a message is waiting for that particular subscriber (col. 4, lines 25-38).

Regarding claims 22, 36, data message platform 40 can be coupled to the telecommunications network 60 via a service control point (col. 2, lines 42-53).

Regarding claims 24, 29, 38, 43, 44-47, in Bossemeyer, data message platform 40 is an email server connected to data network 200 (col. 2, lines 65-66).

Regarding claims 28 and 42, Bossemeyer teaches the use of a stutter dial tone to indicate the presence of a waiting email message (col. 3, lines 17-25).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bossemeyer and Vonder Haar, as applied to claims 16 and 30 above, and further in view of Cook (US 6,732,101).

The combination of Bossemeyer and Vonder Haar differs from claims 21 and 35 in that it does not specify communicating in an encrypted manner. However, Cook teaches the desirability of communicating email messages using encryption (Abstract) in order to prevent unauthorized eavesdropping (col. 1, lines 18-38; col. 2, lines 39-55). It would have been obvious to an artisan of ordinary skill to incorporate such use of encryption, as taught by Cook, within the combination of Bossemeyer and Vonder Haar in order to provide secure email services.

Response to Arguments

5. Applicant's arguments with respect to claims 16, 18, 20-30, 32, 34-47 have been considered but are moot in view of the new grounds of rejection.

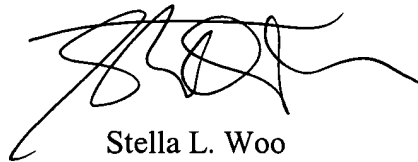
Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (703) 305-4395. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703) 305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'Stella L. Woo', written in a cursive, flowing style.

Stella L. Woo
Primary Examiner
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